

### REMARKS

Claims 1-13, 21-23, and 27-36 are pending in this case. Claims 14-20 and 24-26 have been cancelled in light of the prior Restriction Requirement. Claim 5 has been amended to advance the prosecution of the subject application. New claim 36 has been added. Applicants respectfully request that the subject application be reconsidered in view of the above amendments and the following remarks.

Claims 1, 5-6, and 8-10 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Fitzmaurice et al.* (US 6,870,657). This rejection is respectfully traversed.

Independent claim 1 recites an electrode member, in which the particles in the coating member comprise Sn and Sb in a ratio from about 6:1 to about 10:1. The electrode member of the claimed invention is capable of generating ozone. The cited portions of *Fitzmaurice et al.* do not teach the above claim features in independent claim 1.

The Office Action concedes, "*Fitzmaurice et al.* does not specify the Sb:Sn ratio as claimed" (see paragraph 7 of the Office Action). Accordingly, the ratio range recited in independent claim 1 cannot overlap nor lie inside a ratio range taught by *Fitzmaurice et al.* Therefore, there is no *prima facie* case of obviousness (see, MPEP § 2144.05).

Moreover, *Fitzmaurice et al.* teaches an electrochromic device, which uses nanostructured metal oxide films doped to metallic levels of conductivity and optionally modified (see Abstract). In the cited portions, *Fitzmaurice et al.* merely shows the weight percentage of SnO<sub>2</sub>:Sb in the starting material. The cited portions of *Fitzmaurice et al.* do not teach any ratios of Sn and Sb in the resulting SnO<sub>2</sub>:Sb films, as conceded in the Office Action, or otherwise varying such ratios. In view of the above, it would not be obvious for one skilled in the art to look to the general teachings of SnO<sub>2</sub>:Sb in *Fitzmaurice et al.* and modify the ratio of Sn and Sb to arrive at the claimed invention. Therefore, independent claim 1 is not obvious over *Fitzmaurice et al.* for the above additional reasons.

Independent claim 5 recites that “the electrode member is capable of generating ozone.” The cited portions of *Fitzmaurice et al.* do not disclose the above claim features in independent claim 5.

*Fitzmaurice et al.* relates to a coating material used for antistatic high reflective index film. The cited portions of *Fitzmaurice et al.* do not disclose or relate to an electrode member capable of generating ozone, as is recited in independent claim 5. The electrochromic devices in *Fitzmaurice et al.* operate under a voltage of 1.2 V or less. *Fitzmaurice et al.* does not show that the electrode material has electrochemical property at a voltage more than 1.8 V, which is necessary for ozone generation. Typically, electrodes will generate only oxygen and not ozone at a voltage less than 1.8 V. Thus, independent claim 5 is not obvious over *Fitzmaurice et al.*

In light of the above, the invention as recited in independent claims 1 and 5 and dependent claims 6 and 8-10 each patentably distinguish over *Fitzmaurice et al.* Accordingly, the subject rejection is believed to have been overcome.

Claims 2-4 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Fitzmaurice et al.* (US 6,870,657) in view of *Kotz et al.* (US Patent 4,839,007). This rejection is respectfully traversed. Claims 2-4 depend from independent claim 1 directly or indirectly. The additional reference is cited in connection with the claim features in the dependent claims and does not remedy the deficiencies of *Fitzmaurice et al.* Therefore, claims 2-4 are each allowable for at least the same reasons that independent claim 1 is allowable. Accordingly, the subject rejection has been overcome.

Claims 5 and 7 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Kinoshita et al.* (US 5,446,339). This rejection is respectfully traversed.

Independent claim 5 recites that “the electrode member is capable of generating ozone.” *Kinoshita et al.* does not teach the above claim features.

The cited portions of *Kinoshita et al.* do not disclose or relate to an electrode member capable of generating ozone, as recited in independent claim 5. In *Kinoshita et al.*, a mixture of Sb-doped SnO<sub>2</sub> powder and a black colored electrically conductive powder (carbon) is used as an antistatic coating. The minimum content of conductive fine powder is 1% and can be up to 30% (see, col. 4, ll. 44-60). The SnO<sub>2</sub>:Sb material cannot function without the additional black colored conductive powder. The presence of this powder (*e.g.* carbon) facilitates oxygen evolution and prevents ozone generation.

In light of the above, the invention as recited in independent claim 5 and its dependent claim 7 each patentably distinguish over *Kinoshita et al.* Accordingly, the subject rejection has been overcome.

Claims 11-13 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Fitzmaurice et al.* in regard to claim 5 as stated above in paragraph 7, and in view of *Alder* (US Patent 3,960,678). This rejection is respectfully traversed. Claims 11-13 depend from independent claim 1 indirectly. The additional reference is cited in connection with the claim features in the dependent claims and does not remedy the deficiencies of *Fitzmaurice et al.* Therefore, claims 11-13 are each allowable for at least the same reasons that claim 1 is allowable. Accordingly, the subject rejection has been overcome.

Claim 21 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Fitzmaurice et al.* as evidenced by *Koizumi et al.* (US 2004/0011665). This rejection is respectfully traversed. Claim 21 depends from independent claim 1. The additional reference is cited in connection with the claim features in claim 21 and does not remedy the deficiencies of *Fitzmaurice et al.* Therefore, claim 21 is allowable for at least the same reasons that claim 1 is allowable. Accordingly, the subject rejection has been overcome.

Claims 22-23, 27, 29-32, and 34 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Fitzmaurice et al.* in view of *Kotz et al.* and is evidenced by *Koizumi et al.* and *Murphy et al.* (US 5,972,196). This rejection is respectfully traversed. Claims 22-23, 27, 29-32, and 34 depend from independent claim 1 indirectly. The additional reference is cited in connection with the claim features in the dependent claims and does not remedy the deficiencies of *Fitzmaurice et al.* Therefore, claims 22-23, 27, 29-32, and 34 are each allowable for at least the same reasons that claim 1 is allowable. Accordingly, the subject rejection has been overcome.


Claim 28 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Fitzmaurice et al.* and *Murphy et al.*, and further in view of *McGuire* (US Patent 6,368,472). This rejection is respectfully traversed. Claim 28 depends from independent claim 1 indirectly. The additional reference is cited in connection with the claim features in claim 28 and does not remedy the deficiencies of *Fitzmaurice et al.* Therefore, claim 28 is allowable for at least the same reasons that claim 1 is allowable. Accordingly, the subject rejection has been overcome.

Claims 33 and 35 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Fitzmaurice et al.* in view of *Kotz et al.* and as evidenced by *Koizumi et al.*, *Murphy et al.* and *Zen et al.* (US Patent 5,855,760). This rejection is respectfully traversed. Claims 33 and 35 depend from independent claim 1 indirectly. The additional references are cited in connection with the claim features in the dependent claims and do not remedy the deficiencies of *Fitzmaurice et al.* Therefore, claims 33 and 35 are each allowable for at least the same reasons that claim 1 is allowable. Accordingly, the subject rejection has been overcome.

Applicants have shown that claims 1-13, 21-23, and 27-35 are patentable over the cited art and hereby respectfully request that the rejections of these claims be withdrawn. Each of the pending claims 1-13, 21-23, and 27-36 in this application is thus believed to be in immediate condition for allowance and such action is earnestly solicited.

Respectfully submitted,

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By  (40,414)  
Hua Gao Reg. No.: 40,414  
**DICKSTEIN SHAPIRO LLP**  
1177 Avenue of the Americas  
41st Floor  
New York, New York 10036-2714  
(212) 277-6500  
Attorney for Applicant